



Attorney Docket No. 1332.0189C

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the PATENT application of

Ernie L. Deacon et al.

Serial No.: 10/039,338

Filed: October 29, 2001

For: Golf Shoe Cleat

Group Art Unit: 3728

Examiner: Patterson, M.

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Bry  
C. Patterson  
1/21/03

APPELLANT'S BRIEF

Hon. Assistant Commissioner for Patents  
Washington, D. C. 20231

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Sir:

This Brief is filed pursuant to 37 C.F.R. § 1.192, in triplicate, in support of Appellant's Notice of Appeal filed on October 16, 2002. The appeal is from the final rejection of the Examiner dated September 24, 2002. A Request For Extension of Time (with check for \$110.00) accompanies this Brief.

Pursuant to 37 C.F.R. § 1.17(c), Appellants enclose herewith a check in the amount of \$320.00 in payment of the Brief filing fee. The Commissioner is hereby authorized to charge payment of any additional fees required in connection with the filing of this Brief, or credit any overpayment, to Deposit Account No. 05-0460.

In view of the arguments and supporting authorities set forth below, the Board of Patent Appeal and Interferences (BPAI) should find the rejections of claims 18 – 34 to be in error and should reverse those rejections.

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1. Real Parties In Interest:

The real party in interest in the subject application is Softspikes, Inc., a corporation of the State of Delaware and having a place of business at 806 W. Diamond Avenue, Suite #200, Gaithersburg, Maryland 20878.

2. Related Appeals and Interferences:

There are no related pending Appeals or Interferences. A parent application (Serial No. 08/734,205, now U.S. Patent No. 6,327,797), from which the present application is a continuation, was the subject of Appeal No. 1999-2103, decided March 27, 2001.

3. Status of Claims:

Claims 18 – 34, the only claims in the application, are on appeal, and all stand rejected. These claims were first presented in a preliminary amendment filed with the application. Only claim 27 has been amended, the amendment having been made on August 19, 2002, to correct informalities in the claim.

4. Status of Amendments:

There have been no amendments filed subsequent to the Final Rejection.

5. Summary of the Invention:

The invention defined in the claims on appeal is a golf cleat 10 (or a shoe having such a cleat) that provides traction for golfers without damaging turf being walked upon. Golf cleat 10 includes a flange 12 and a plurality of traction elements in the form of protrusions 15 on flange 12. The protrusions 15 are presented to the turf in order to provide traction (spec. page 6, lines 14 -15) without causing damage to turf (spec. page 3, lines 15 – 18; page 5, lines 9 – 10; page 6, lines 15 – 16). The protrusions may have a variety of configurations (spec. page 4, lines 3 – 4; page 6,

lines 11-13), and in the preferred embodiment may be elongated ribs (spec. page 6, lines 25 – 26).

6. The Issues On Appeal:

The following issues are presented for appeal:

- A. whether under 35 U.S.C. §112, first paragraph, claims 18 – 25 contain subject matter not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time that the application was filed, had possession of the claimed invention;
- B. whether under 35 U.S.C. §112, second paragraph, claims 18 – 25 fail to particularly point out and distinctly claim the subject matter which Appellants regard as their invention;
- C. whether claims 18 – 20, 22, 26 – 30 and 34 are anticipated under 35 U.S.C. §102(b) by U. S. Patent No. 3,583,082 (Jordan, Jr., hereinafter “Jordan”);
- D. whether claim 21 is rendered obvious under 35 U.S.C. §103(a) by Jordan;
- E. whether claims 25 and 33 are rendered unpatentable under 35 U.S.C. §103(a) by Jordan in view of U.S. Patent No. 2,491,596 (Zaleski) ;
- F. whether claims 18 – 34 are properly rejected under the judicially created doctrine of double patenting over claims 1 – 13 of U. S. Patent No. 6,354,021; and
- G. whether claims 18 – 34 are properly rejected under the judicially created doctrine of double patenting over claims 1 – 10 of U. S. Patent No. 5,259,129.

7. Grouping Of Claims:

As to the rejections under 35 U.S.C. §112 identified above as issues on appeal, the claims subject to those rejections stand or fall together with respect to those rejections. As to the rejections based on 35 U.S.C. §102 and 35 U.S.C. §103 identified above as issues on appeal, the claims subject to those rejections do not stand or fall together.

8. Argument:

A. The rejection 35 U.S.C. §112, first paragraph.

Claims 18 – 25 stand rejected as containing subject matter not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time that the application was filed, had possession of the claimed invention. Specifically, the phrase “traction means”, added by amendment, is deemed by the Examiner to constitute new matter.

Initially, it is submitted, as to the rejection based on §112, first paragraph, that the Examiner has not cited any relevant case law or other precedent in support of the unique theory employed in this rejection. On the contrary, the case law and precedent cited herein and cited previously by Appellants are clearly contrary to the Examiner’s position. The only attempt at a case citation by the Examiner is in the Final Rejection at page 8 where the Examiner cites *In re Donaldson*, 29 USPQ2d, 1845, 1850 (Fed. Cir. 1994). However, the cited portion of *Donaldson* pertains to §112, sixth paragraph, not first paragraph. This rejection closely follows the BPAI’s own rejection, made on the BPAI’s own initiative, in Appeal No. 1999-2103 concerning Appellants’ parent application. In view of the apparent interaction between the first and sixth paragraphs of §112, Appellants feel compelled to point out below the relationships between paragraphs 1, 2 and 6 of §112 before turning to the inapplicability of all of these paragraphs of §112 as grounds for rejecting claims 18 – 25.

Reference is made to *Atmel Corp. v. Information Storage Devices Inc.*, 53 USPQ2d 1225, 1230 (Fed. Cir.) wherein the Federal Circuit clearly enunciates the relationships between the paragraphs of the statute at issue:

“For the sake of clarity, we first set out in one place the provisions of Section 112, Paragraphs 1, 2, and 6.

Section 112. Specification [Para. 1]The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention. [Para. 2]The specification

shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention. [Para. 6]An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof. 35 U.S.C. Section 112, Paragraphs 1, 2, and 6 (1994).

Paragraph 1 is, *inter alia*, an enablement provision requiring that an inventor set forth in the patent specification how to make and use his or her invention. Paragraph 2 requires claims that particularly and distinctly indicate the subject matter that the inventor considers to be his or her invention. Paragraph 6 also addresses claim language, but refers to the specification for its meaning. In doing so, it specifically refers to "structure . . . described in the specification and equivalents thereof." *Id.* Section 112, Para. 6. This provision represents a *quid pro quo* by permitting inventors to use a generic means expression for a claim limitation *provided that* the specification indicates what structure(s) constitute(s) the means. See *O.I. Corp. v. Tekmar Co.*, 115 F.3d 1576, 1583, 42 USPQ2d 1777, 1782 (Fed. Cir. 1997). The language indicates that means-plus-function clauses comprise not only the language of the claims, but also the structure corresponding to that means that is disclosed in the written description portion of the specification (and equivalents thereof). Thus, in order for a claim to meet the particularity requirement of Para. 2, the corresponding structure(s) of a means-plus-function limitation must be disclosed in the written description in such a manner that one skilled in the art will know and understand what structure corresponds to the means limitation. Otherwise, one does not know what the claim means." (Emphasis in original)

Considering first §112-1, there can be no argument about whether or not Appellants have "set forth in the patent specification how to make and use" their invention. The protrusions 15 are clearly disclosed as elements that provide traction (i.e., "traction means") without damaging and puncturing turf. Considering next §112-2, claim 18 recites such traction means in a manner that "particularly and distinctly indicates the subject matter that the inventor considers to be his or her invention". Importantly, §112-2 relates to what the inventor considers to be his invention, not what the examiner considers to be the inventor's invention. Considering §112-6, Claim 18 contains language that reads directly on "structure . . . described in the specification". In other words, the "means plus function" format,

expressly permitted by §112-6, need only read on a disclosed embodiment and is construed to include undisclosed equivalents of the disclosed embodiment. (This point is expanded below). Accordingly, Appellants, in claim 18, have met the requirements of §§112-1, 2 and 6.

The following expands on the foregoing.

First, regarding the sixth paragraph of §112, the BPAI, in Appeal No. 1999-2103 (on which the Examiner appears to rely), effectively (and, it is submitted, erroneously) held that a means-plus-function claim requires a description in the specification of the equivalents invoked by 35 U.S.C. §112, sixth paragraph. This turns the statutory language on its head and, not surprisingly, is contrary to all precedent. See *In re Noll*, 191 USPQ 721, 727 (CCPA 1976) ("The meaning of 'equivalents' is well understood in patent law, and an applicant need not describe in his specification the full range of equivalents of his invention, some of which may be nonexistent at the time the application is filed." (citation omitted)). If a means-plus-function limitation is to be interpreted, as set forth in the statute, as "cover[ing] the corresponding structure... described in the specification and equivalents thereof," then by definition, the equivalents are something not described *in haec verba* in the specification. *Noll*, 191 USPQ at 727 (noting that section 112, sixth paragraph, equivalents "may be nonexistent at the time the application is filed"); see also *Texas Instruments, Inc. v. U.S. Int'l Trade Comm'n*, 231 USPQ 833, 839 (Fed. Cir. 1986) holding that the ALJ erred (in limiting the structure corresponding to means-plus-function claim limitations to the embodiment disclosed in the specification) because "[t]he statute, §112-6, was written precisely to avoid a holding that a means-plus-function limitation must be read as covering only the means disclosed in the specification" (citation omitted). If a first embodiment is described, forming the "corresponding structure" specified in the statute, and equivalents also are described, those equivalents are in fact "corresponding structures," and other, still undescribed, structures are the statutory equivalents. *Noll*, 191 USPQ at 727.

Thus, in the rejection under 35 U.S.C. §112, first paragraph, the Examiner has held that Appellants introduced new matter by introducing means-plus-function claims covering undescribed equivalents. But if, as is the case by statutory definition, one need not describe the equivalents, then means-plus-function claims

always define undescribed subject matter. Yet the statute expressly permits such claims, and they cannot logically be rejected under 35 U.S.C. §112, first paragraph, as not being supported.

The Examiner apparently is of the opinion that the timing of the submission of the claims is relevant. That is, since the means-plus-function claims were not in the application as filed, the Examiner reasons that Appellants added subject matter by adding mean-plus-function claims that, after the filing date, covered equivalents that were not previously covered. However, "new matter" (see 35 U.S.C. § 132) is not the proper basis for a rejection under §112-1; the only issue under §112-1 is whether the claim being considered can be read on the disclosure in the specification. *In re Rasmussen*, 211 USPQ 323, 326 (CCPA 1981) ("The proper basis for rejection of a claim amended to recite elements thought to be without support in the original disclosure, therefore, is §112, first paragraph, not §132"); *Noll*, 191 USPQ at 727 (noting that a rejection based on the "lack of any corresponding descriptions of structure in the specification upon which the scope of equivalents might be based" is properly made under §112, first paragraph) (quotation omitted); *Amtel Corp.*, *supra*. As discussed above, the specification need not expressly recite the statutorily stated equivalents, and by definition cannot expressly recite them.

As long as there is at least one disclosed structure, Appellants are entitled to a claim in means-plus-function format that covers that disclosed structure and its equivalents. As the CCPA stated in *Rasmussen*:

"Section 132 prohibits introduction of new matter into the disclosure of an application. Section 112, first paragraph, requires that claim language be supported in the specification.

\* \* \*

Broadening a claim does not add new matter to the disclosure. Disclosure is that which is taught, not that which is claimed. An applicant is entitled to claims as broad as the prior art and his disclosure will allow." *Rasmussen*, 211 USPQ at 325-26 (citations and emphasis omitted).

By making timing an issue, the Examiner appears to be attempting, inappropriately and without any cited authority, to resurrect the "late-claiming" doctrine disposed of almost twenty years ago by the Court of Appeals for the Federal Circuit in *Railroad Dynamics, Inc. v. A. Stucki Co.*, 220 USPQ 929, 940 (Fed. Cir. 1984).

Thus, it is well established that broadening a claim during prosecution does not add new matter to the disclosure, and that, as long as the claims read on the disclosure, an applicant is entitled to claims as broad as the prior art and his disclosure will allow. *Rasmussen*, 211 USPQ at 325. Further, citing *Ralston Purina Co. v. Far-Mar-Co, Inc.*, 227 USPQ 177, 179 (Fed. Cir. 1985), the Federal Circuit stated, in *Utter v. Hiraga*, 6 USPQ2d 1709, (CAFC 1988) that: "A specification may, within the meaning of 35 U.S.C. §112 ¶1, contain a written description of a broadly claimed invention without describing all species that claim encompasses." The CAFC, in *Texas Instruments, Inc. v. U.S. Int'l Trade Comm'n*, 231 USPQ 833, 839 (Fed. Cir. 1986) held that an ALJ erred in limiting the structure corresponding to means-plus-function claim limitations to the embodiment disclosed in the specification because the statute, §112-6, was written precisely to avoid a holding that a means-plus-function limitation must be read as covering only the specific means disclosed in the specification.

The meaning of "equivalents" is well understood in patent law, and an applicant need not describe in the specification the full range of equivalents (or, for that matter, any equivalents) of the invention, some of which may be nonexistent at the time the application is filed. *Noll*, 191 USPQ at 727. If, as expressly required by the statute, a means-plus-function limitation is to be interpreted as covering "the corresponding structure..... described in the specification and equivalents thereof" (emphasis added), then, by definition, the equivalents are something not described *in haec verba* in the specification. *Noll*, 191 USPQ at 727 (noting that section 112, sixth paragraph, equivalents "may be nonexistent at the time the application is filed"); see also *Texas Instruments, Inc. v. U.S. Int'l Trade Commission, supra*. If a preferred embodiment is described in the specification, and other embodiments are also described, those other embodiments are in fact "corresponding structures," under §112-6; any other undescribed structures are the statutorily defined

"equivalents thereof". *Noll*, 191 USPQ at 727. The Examiner's position would, in effect, render the "equivalents thereof" language in the statute meaningless, and that has long been recognized as impermissible statutory construction. *United States v. Menasche*, 349 U.S. 528, 538-39 (1955) ("It is our duty to give effect, if possible, to every clause and every word of a statute."); *Platt v. Union Pacific R.R.*, 99 U.S. 48, 58 (1876) ("But the admitted rules of statutory construction declare that a legislature is presumed to have used no superfluous words. Courts are to accord a meaning, if possible, to every word in a statute."); See also: *In re Finch*, 190 USPQ 64, 65 (CCPA 1976); and *In re Barker and Pehl*, 194 USPQ 470 (CCPA 1977). In other words, the Examiner, in misinterpreting §112-1 to effectively read "equivalents thereof" out of §112-6, is proceeding directly contrary to the dictates of both the U.S. Supreme Court and the CCPA, the predecessor court of the Federal Circuit.

The M.P.E.P. is entirely consistent with the foregoing statement of the law. Specifically, M.P.E.P. section 2184 states as follows:

"To interpret the 'means plus function' limitation as limited to a particular means set forth in the specification would nullify the provisions of 35 U.S.C. 112 requiring that the limitation shall be construed to cover the structure described in the specification and equivalents thereof." (emphasis in original),

citing *D.M.I., Inc. v. Deere & Co.*, 225 USPQ 236, 238 (Fed. Cir. 1985). Moreover, M.P.E.P. section 2182, citing the *Noll* case, states:

"The specification need not describe the equivalents of the structures, material, or acts corresponding to the means- (or step-) plus-function claim element".

Against all of this authority and precedent, the Examiner cites not a single relevant case or other item of authority. This is not surprising, since the concept underlying the rejection is so contrary to U.S. patent practice as to be shocking. The USPTO and patent practitioners have long understood that a "means-plus-function" claim, whether filed as part of the original application or added during prosecution, is permissible, provided that it reads on a disclosed embodiment and is not anticipated by prior art. Disclosure of only a single limited embodiment of a claim element supports any added "means plus function" recitation as long as the "function" is performed by that disclosed embodiment.

Applying the foregoing to the present case, the Examiner states that Appellants introduced new matter by introducing means-plus-function claims covering undescribed equivalents. However, if (as by definition must be the case) an applicant need not describe the equivalents, then means-plus-function claims always define undescribed subject matter. The statute expressly permits such claims, and makes no distinction as to when they may be presented during prosecution. Therefore, such claims cannot be rejected under 35 U.S.C. §112, first paragraph, as not being supported, as long they read on one disclosed embodiment.

It must be noted that Appellants have clearly indicated in the specification that the traction means may take a "variety of configurations" (spec. page 4, line 3; page 6, line 12). The Examiner states in the Final Rejection (Final Rejection at Page 7, line 13) that she is "at a loss as to what structures would be considered to be equivalents". Since Appellants are well aware of this Examiner's extensive experience and qualifications in examining applications in the field of shoe cleats, Appellant's must assume that this statement by the Examiner reflects advocacy of her position rather than a lack of qualifications. The "means" for which equivalents are at issue is "traction means" wherein the cleat "provides traction against the ground without doing damage to the turf surface being walked on and without puncturing golf turf". The concept of non-penetrating cleat design for providing traction is known for surfaces, other than golf turf, wherein penetration is not possible such as, for example, a running track or artificial grass. The Examiner tacitly admits this in her citation and application of the Jordan patent against Appellants' claims (see section 8.C below at page 12). Another example of record in the present application is U.S. patent No. 3,512,275 (Leavitt). There are numerous other designs known in the prior art, e.g., U.S. Patent No. 3,656,245 (Wilson). Thus, at the time that Appellants recognized the need for a cleat that would provide traction on penetrable natural golf turf without penetrating that turf, persons skilled in the art of cleat design already knew of the Jordan, Leavitt, Wilson and other cleats used as traction means for non-penetrable artificial turf. Although such cleats would not avoid penetrating natural turf, persons skilled in the art were aware that lateral traction along a surface could be achieved even though penetration is precluded by the nature of the surface, rather than by the cleat itself.

Is the Examiner saying that the skill level in cleat design is so low that cleat designers, armed with Appellants' discovery that turf penetration could be avoided by the cleat structure itself, would not be aware of other designs that would provide lateral traction while also preventing penetration? The fact that Appellants specifically disclose that there are a "variety of configurations" for the traction elements, and the knowledge in the art that lateral traction is possible impenetrable surfaces, is believed to support the addition of means plus function claims without the addition of new matter.

Accordingly, it is submitted that the rejection under 35 U.S.C. §112, first paragraph, is improper and should be withdrawn.

B. The rejection 35 U.S.C. §112, second paragraph.

Similarly, in the rejection of claims 18 - 25 under 35 U.S.C. §112, second paragraph, the Examiner reasons that because the equivalents covered by the means-plus-function claims are not specifically described, the scope of the claim is indefinite. As an initial matter, the CCPA has explicitly reversed a rejection on the these very grounds in *In re Noll*. *Noll*, 191 USPQ at 727. Moreover, as noted above, equivalents, by definition, are never disclosed. Therefore, such claims cannot properly be rejected as indefinite if there is at least one corresponding structure clearly described in the specification. *Atmel Corp. v. Information Storage Devices, Inc.*, 198 F.3d 1374, 1382, 53 USPQ2d 1225, 1230 (Fed. Cir. 1999) ("All one needs to do in order to obtain the benefit of that claiming device [§112, sixth paragraph] is to recite some structure corresponding to the means in the specification, as the statute states, so that one can readily ascertain what the claim means and comply with the particularity requirement of [§112,] ¶ 2.").

As with the previously discussed rejection under §112 first paragraph, once again there is no precedent cited in support of the Examiner's position. The Examiner argues that, because the equivalents covered by the means-plus-function claims are not disclosed, the scope of the claim is indefinite. This is contrary to the requirements of M.P.E.P. section 2181 wherein, citing the *Noll* case, it is stated:

"[u]nless the means-plus-function language is itself unclear, a claim limitation written in means-plus-function language meets the definiteness requirement in 35 U.S.C. 112,

second paragraph so long as the specification meets the written description requirement in 35 U.S.C. 112, first paragraph."

The Examiner is not alleging that the disclosure of Appellants' protrusions or ridges does not meet the written description requirement in 35 U.S.C. §112, first paragraph. Further, there is no issue regarding the definiteness of the means-plus-function language *per se*. Therefore, the means-plus-function language, since it reads on disclosed structure, must, according to the M.P.E.P., meet the definiteness requirement in 35 U.S.C. §112, second paragraph

In summary, the CCPA has explicitly reversed a rejection on the these very grounds in *Noll*, (191 USPQ at 727). Moreover, as noted above, equivalents as that term is used in §112, by definition, are never disclosed. Therefore, such claims cannot be rejected as indefinite if there is at least one corresponding structure clearly described in the specification. *Atmel Corp.* 53 USPQ2d at 1230 ("All one needs to do in order to obtain the benefit of that claiming device [§112, sixth paragraph] is to recite some structure corresponding to the means in the specification, as the statute states, so that one can readily ascertain what the claim means and comply with the particularity requirement of [§112,] ¶ 2.").

For all of these reasons, claims 18-25 are in compliance with 35 U.S.C. §112, first and second paragraphs, and are therefore patentable.

C. The rejection under 35 U.S.C. §102(b)

Claims 18 – 20, 22, 26 – 30 and 34 stand rejected as anticipated under 35 U.S.C. §102(b) by U. S. Patent No. 3,583,082 (Jordan, Jr., hereinafter "Jordan").

It must be noted that this rejection is in conflict with the position taken by the Examiner in the rejection under 35 U.S.C. §112, first paragraph. The §112-1 rejection is based on the position that there are no disclosed equivalents for the "traction means" recited in, for example, claim 18. Therefore, according to the Examiner, claim 18 adds new matter. This must be viewed in connection with the fact that the Federal Circuit has clearly charged the USPTO, when searching prior art for correspondence to a "means plus function" recitation, with the responsibility of considering §112-6 to determine whether or not prior art falls within the scope of the

statutory equivalents of the recited means. See *In re Donaldson*, 29 USPQ2d 1845, 1848-1849 (Fed. Cir. 1994). This requirement is also stated in section 2182 of the M.P.E.P. Thus, if the Examiner is, as she must be, following the dictates of the M.P.E.P. and the *Donaldson* case, the Examiner, at least tacitly, considers the Jordan traction elements to be included within the scope of equivalents of the claimed "traction means", since clearly the ridges disclosed by Appellants are not identical to the bristles 18 disclosed by Jordan. That being the case, for purposes of the §102 rejection, the bristles must be deemed by the Examiner to be "equivalents" of the ridges. However, if Appellants' ridges have any "equivalents" whatsoever, then the Examiner's rationale for the § 112-1 rejection based on new matter cannot stand, whether supported by authority or not. "Equivalents" cannot be manipulated and construed in opposite ways to serve different purposes. In responding to the initial Office Action, Appellants requested that the Examiner clarify this inconsistency in order to permit Appellants to efficiently address the issues on appeal; no explanation of this inconsistency has been provided.

Apart from the inconsistency, the rejected independent claims 18, 26, 27 and 34 define a removable cleat in which a flange contacts "turf" being walked on and distributes weight over the "turf", while traction means or protrusions from the flange provide traction against the "turf", all without damaging or puncturing the "turf". The Examiner's statement that the flange in Jordan is capable of bearing weight, depending on the surface (e.g., sand), ignores the fact that Appellants' claims require the weight to be distributed over turf. The common meaning of "turf" is "the upper stratum of soil bound by grass and plant roots into a thick mat" as defined in the Merriam-Webster Collegiate Dictionary (On-Line Version); and "a surface layer of earth containing a dense growth of grass and its matted roots" as defined in The American Heritage Dictionary of the English Language, Houghton Mifflin Company, 1992 edition. The Examiner's position takes both the claimed structure and the cited Jordan structure out of their respective operating environments and places them in a nonsensical environment. Would the flange in the Jordan structure bear weight in sand? Jordan is silent on this issue; but in any case, that issue is irrelevant because the claims require the flange to be weight-bearing on turf. If the Examiner is reading the "turf" limitation out of the claims, as would appear to be the

case, such “reading out” is not justified. Words relating to a “claim environment” must be given patentable weight where those words “are necessary to give meaning to the claim and properly define the invention”. *Perkin-Elmer Corp. v. Computervision Corp.*, 221 USPQ 669, 675 (Fed. Cir. 1989). Appellants are claiming a golf cleat and its operation on turf. The “turf” is not only necessary to give meaning to the claim, it is critical to the claim and the proper definition of the invention. Accordingly, how the Jordan spike may function in sand is irrelevant, both because the claims require the flange to distribute weight on “turf”, and because Jordan does not disclose use of his spike in a sand environment or how the spike would function if used in a sand environment.

The only descriptions of “use” in the Jordan patent indicate that the bristles must be stiff enough to support a wearer’s weight and strong enough to maintain substantially the same attitude during use (Jordan, at column 2, lines 25-29). This is the only teaching in Jordan regarding supporting the wearer’s weight. The only weight-supporting function performed by Jordan’s “flange” as disclosed is the indirect support resulting from the transmission of force longitudinally through the bristles to the flange. In other words, the flange never contacts the track. Jordan provides no suggestion whatsoever that the “flange” contacts the track on which it is used (much less turf) to support weight as required by the rejected claims. Certainly, there is no discussion of how the bristles or flange function on granular terrain, such as sand.

Jordan has absolutely no disclosure regarding use on turf because Jordan is designed for running on cinder tracks. Moreover, one would not normally describe the effect of Jordan’s bristles on grass or turf as “indenting”; although Jordan uses the term “indenting,” the “indenting” that Jordan describes, when translated from hard cinder tracks to permeable turf, must be viewed as “puncturing” within the context Appellants’ claim. Stated otherwise, it is impossible for the Jordan cleat to provide traction on turf without puncturing and damaging turf.

As discussed above, the only reasonable reading of Jordan is that the weight of a wearer is borne solely by the longitudinally stiff bristles, and that the weight of a wearer standing on turf would be transmitted fully through those stiff bristles. If the Jordan cleats were used on turf, then, the Jordan bristles cannot help but penetrate

at least to the soil, whereby at least some of the bristles must puncture the crowns of grass plants, because as they bear the wearer's full weight, the bristles must keep going, penetrating whatever is in their path, until the flange of the spike stops them by abutting the soil surface. Further, even if the Jordan spike were used on sand, as suggested by the Examiner, the bristles would also penetrate through the sand, as would any spike or cleat. Clearly, this is contrary to the intended function of the Jordan spike. (As an aside, can the Examiner seriously be contending that any rational person would wear cleats that are intended for providing traction on hard track surfaces on a sandy or other granular surface)? It is submitted that the unyielding bristles of Jordan, which "must be of sufficient stiffness so that they will not collapse or break off when supporting the weight on an athlete", must necessarily either (1) penetrate turf and thereby damage the turf or (2) support the weight of the wearer above the turf and thereby prevent the flange from supporting the weight of the wearer.

It is well established that anticipation under §102 requires the presence, in a single prior art reference, of disclosure of each and every element of the claimed invention. See *Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick Company et al.*, 221 USPQ 481, 485 (CA FC 1984), citing *Connell v. Sears, Roebuck & Co.*, 220 USPQ 193 (Fed. Cir. 1983); and *SSIH Equip. S.A. v. USITC*, 218 USPQ 678 (Fed. Cir. 1983). The absence of any teaching in Jordan of the claimed operation of Appellants' cleat on "turf" precludes any anticipation by Jordan of Appellants' claims.

In view of the foregoing, independent claims 18, 26, 27 and 34 are not anticipated by Jordan.

Claims 19, 20, 22, and 28 – 30 depend from respective ones of these independent claims and are patentable therewith. In addition, claims 19 and 28 require that the traction means/members be made of resilient material; Jordan's bristles are described only as stiff with no suggestion of resiliency. As noted above, a rejection under 35 U.S.C. §102 requires that every feature of a claim be disclosed in a single reference. Accordingly, the rejection of claims 19 and 28 is improper apart from the distinguishing features of their parent independent claims.

#### D. The rejections under 35 U.S.C. §103(a)

Claim 21 stands rejected under 35 U.S.C. §103(a) as unpatentable over Jordan. Claims 25 and 33 stand rejected under 35 U.S.C. §103(a) as unpatentable over Jordan in view of Zaleski (2491596). These rejections are respectfully traversed. Both rejections rely on the misinterpretation of the Jordan disclosure discussed above in connection with the section §102 rejection. Nothing stated in the rejections of these claims, and nothing disclosed by Zaleski, rectifies the deficiencies of the Jordan patent as a reference.

#### E. The Double Patenting Rejections

The Examiner has rejected claims 18 – 34 under the judicially created doctrine of double patenting over claims 1 – 13 of U.S. Patent No. 6354021 (the '021 patent'). The Examiner has also rejected claims 18 – 34 under the judicially created doctrine of double patenting over claims 1 – 10 of U.S. Patent No. 5259129 (the '129 patent). In stating the grounds for these rejections, the Examiner states that the '021 and '129 patents and the present application claim, *inter alia*, "traction means". This statement is made in spite of the fact that the Examiner has refused to permit Appellants to include "traction means" in the claims of the subject application on the grounds that "traction means" constitutes new matter and that "traction means" is vague and indefinite. Thus, in stating this rejection the Examiner is effectively saying that Appellants can recite "traction means" in the claims of the subject application, but in stating the §112 rejections the Examiner is refusing to permit Appellants to recite "traction means". Appellants stand willing to submit appropriate Terminal Disclaimers once the basis for the double patenting rejections are understood; however, the basis for the rejections is unclear in view of the conflicting interpretations of "traction means" employed in the Final Rejection.

9. APPENDIX - CLAIMS ON APPEAL

18. A removable golf shoe cleat for use in a golf shoe having a sole, said sole having a plurality of sole attachment means for attachment of removable cleats, said removable golf shoe cleat comprising:

(a) a flange having an upper surface and an opposing bottom surface that distributes the weight of the wearer of said cleat over turf being walked on;

(b) flange attachment means extending from said upper surface of said flange for removably attaching said cleat to one of said sole attachment means of said sole of said shoe;

(c) a plurality of traction means extending from the opposing bottom surface of said flange, said flange distributing said weight over turf being walked on while said traction means provide traction against said turf; and

(d) said flange and said traction means having a combined profile of at most about 0.25 inch as measured from said upper surface of said flange to a bottom portion of a most downwardly extending portion of said traction means; wherein:

said cleat provides traction against the ground without doing damage to the turf surface being walked on and without puncturing golf turf.

19. The removable golf shoe cleat of claim 18 wherein said traction means comprise a resilient material.

20. The removable golf shoe cleat of claim 18 wherein said traction means comprise a durable plastic material.

21. The removable golf shoe cleat of claim 20 wherein said durable plastic material comprises polyether block urethane.

22. The removable golf shoe cleat of claim 18 wherein said flange attachment means comprises a threaded stud extending from said upper surface of said flange of said cleat.

23. The removable golf shoe cleat of claim 22 wherein:

said traction means extending from said opposing lower surface of said flange comprise ribs; and

each of said ribs has a maximum height between about 0.03125 inch and about 0.125 inch.

24. The removable golf shoe cleat of claim 23 wherein each of said ribs has a length and a series of cross sections taken at different points along said length, each of said cross sections having a respective height, said respective heights varying along said length of said rib.

25. The removable golf shoe cleat of claim 18 wherein said opposing bottom surface of said flange has a convex shape.

26. A removable golf shoe cleat for use in a golf shoe having a sole, said sole having a plurality of sole attachment means for attachment of removable cleats, said removable golf shoe cleat comprising:

(a) a flange having an upper surface and an opposing lower surface that distributes weight of a wearer of said cleat over turf being walked on;

(b) flange attachment means extending from the upper surface of said flange for removably attaching said cleat to one of said sole attachment means of said sole of said shoe; and

(c) a plurality of protrusions on said opposing lower surface of said flange, said flange contacting turf being walked on and distributing said weight over said turf being walked on and distributing said weight over said turf while said protrusions provide traction against said turf; wherein:

said protrusions provide traction against the ground without doing damage to the turf surface being walked on and without puncturing golf turf.

27. A removable golf shoe cleat for use in a golf shoe having a sole, said sole having a plurality of cleat receiving members for attachment of respective removable cleats, said removable golf shoe cleat comprising:

(a) a flange having an upper surface and an opposing bottom surface that distributes the weight of the wearer of said cleat over turf being walked on;

(b) a flange attachment member extending from said upper surface of said flange for removably attaching said cleat to one of said cleat receiving members of said sole of said shoe; and

(c) a plurality of traction members extending from the opposing bottom surface of said flange, said flange distributing said weight over turf being walked on while said traction members provide traction against said turf; and

(d) said flange and said traction members having a combined profile of at most about 0.25 inch as measured from said upper surface of said flange to a bottom portion of a most downwardly extending portion of said traction members;

wherein said cleat provides traction against the ground without doing damage to the turf surface being walked on and without puncturing golf turf.

28. The removable golf shoe cleat of claim 27 wherein said traction members comprise a resilient material.

29. The removable golf shoe cleat of claim 27 wherein said traction members comprise a durable plastic material.

30. The removable golf shoe cleat of claim 27 wherein said flange attachment member comprises a threaded stud extending from said upper surface of said flange of said cleat.

31. The removable golf shoe cleat of claim 30 wherein:

said traction members extending from said opposing lower surface of said flange comprise ribs; and

each of said ribs has a maximum height between about 0.03125 inch and about 0.125 inch.

32. The removable golf shoe cleat of claim 31 wherein each of said ribs has a length and a series of cross sections taken at different points along said length, each of said cross sections having a respective height, said respective heights varying along said length of said rib.

33. The removable golf shoe cleat of claim 27 wherein said opposing bottom surface of said flange has a convex shape.

34. A removable golf shoe cleat for use in a golf shoe having a sole, said sole having a plurality of sole attachment means for attachment of removable cleats, said removable golf shoe cleat comprising:

(a) a flange having an upper surface and an opposing lower surface that distributes weight of a wearer of said cleat over turf being walked on;

(b) flange attachment means extending from the upper surface of said flange for removably attaching said cleat to one of said sole attachment means of said sole of said shoe; and

(c) a plurality of traction elements formed as a unitary plastic body with said flange and extending downward beyond said opposing lower surface of said flange, said flange facing away from said sole to contact and distribute said weight on turf being walked on while said traction elements provide traction on said turf;

wherein said traction is provided without doing damage to said turf and without puncturing golf turf.

10. Conclusion

In view of the foregoing it is submitted that the rejections of claims 18 - 34 are improper and should be reversed.

Respectfully submitted,



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